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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,283	09/30/2002	John F. Braun	F-523	5698

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EXAMINER

OSBORNE, LUKE R.

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/065,283	<b>Applicant(s)</b> BRAUN ET AL.	
	<b>Examiner</b> Luke Osborne	<b>Art Unit</b> 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/6/04, 9/30/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because page 14 of the application states "Figures" as the title and no figures are on the page. The examiner suggests this otherwise blank page be stricken from the record.

### ***Specification***

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that

Art Unit: 2171

the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is less than 50 words, and should not repeat information given in the title. It should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

2. Claim 7 is objected to because of the following informalities: The limitation "pre-printed ion the form in a dashed font" on line 2, "ion" is presumed to be a typo. In the interest of a compact prosecution the examiner presumes "ion" to be "on". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-2, 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0006212 submitted by Rhoads et al., in view of U.S. Patent No. 6,666,376 to Ericson. Unless otherwise noted all references are to the primary reference of Rhoads.

Per claim 1, Rhoads discloses a method for identifying a version of a form. See Figures 1, 2A-C, and 5 and the corresponding portions of Rhoad's specification for this disclosure. In particular Rhoads teaches a method for identifying a version of a form comprising:

- initializing a client [handheld computer 10] having a form version database [a database can be used to track documents and revisions, (Paragraph 55, lines 9-10)];

Art Unit: 2171

- determining if the form version database must be updated [it is common in the art of distributed databases to update the remote database];
- and obtaining form version data [watermark] from the form; and
- determining whether the form is an acceptable version using the form version database and the form version data [the document data (watermark) is compared with the database information information to determine whether the printed copy is the most recent copy (Paragraph 57, lines 1-3)].

Rhodes does not explicitly disclose that the client is a pointing instrument [However, Rhodes recognizes that any improved components may be suitably interchanged with their invention. (Paragraph 26, lines 11-12)]

Ericson discloses a method similar to Rhodes, in which both interface with physical paper using handheld computing devices. Both systems are also able to determine the version of the document at hand. See Figures 1, 3, 7, 8 and 9 and the corresponding portions of Ericson's specification for this disclosure. In particular, Ericson's system uses a pointing device, more specifically a pen as the handheld computer [Ericson : Figure 7].

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to use Ericson's pen computer with the method of Rhodes with the motivation as discussed above.

Per claim 2, the system and method of Rhodes in view of Ericson as applied to claim 1 above discloses the claimed invention. See Ericson Figures 1, 3, 7, 8 and 9 and

Art Unit: 2171

the corresponding portions of Ericson's specification for this disclosure. In particular, wherein the pointing instrument is a digital pen [Ericson: Figure 7, and Figure 8 item 81].

Per claim 5, the system and method of Rhodes in view of Ericson as applied to claim 2 above discloses the claimed invention. In particular, wherein the form version data is obtained by obtaining user stroke data [A hand-written entry can constitute a third information layer (Ericson: Column 3, lines 66-67)].

Per claim 6, the system and method of Rhodes in view of Ericson as applied to claim 5 above discloses the claimed invention. In particular, wherein the user stroke data is obtained when the user traces over a form indicator [Ericson: function field (Column 4, lines 61-65)].

Per claim 7, the system and method of Rhodes in view of Ericson as applied to claim 6 above discloses the claimed invention. In particular, wherein the form indicator is a serial number pre-printed [absolute position coding pattern 9 (Ericson: Column 6, lines 39-40)] on the form in a dashed font. The limitation "dashed" is considered to be a design choice and given no patentable weight. Instead of a dashed font to distinguish the serial number it could be in bold, grayscale, or a different color.

Per claim 8, the system and method of Rhodes in view of Ericson as applied to claim 1 and 2 above discloses the claimed invention. In particular, a digital pen comprising [See the discussion regarding claim 2 above]:

- a processor [CPU (Fig. 1, item 12)];
  - a storage device connected to the processor [Memory (Fig. 1, item 14)];
- and
- the storage device storing a form version database [a database can be used to track documents and revisions, (Paragraph 55, lines 9-10)].

5. Claim 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0006212 submitted by Rhoads et al., in view of U.S. Patent No. 6,666,376 to Ericson as applied to claim 2 above, and further in view of U.S. Patent Application Publication No. 2002/0169963 submitted by Seder et al. Unless otherwise noted all references are to the primary reference of Rhoads.

Per claim 3, the system and method of Rhodes in view of Ericson as applied to claim 1 and 2 above in view of Seder discloses the claimed invention. In particular, wherein the form version data is obtained by scanning an RF-ID tag [watermark].

The system and method of Rhodes in view of Ericson does not teach that the identification watermark could be in the form of an RF-ID tag.

Seder discloses a similar watermarking system to Rhodes modified by Ericson in that they both use identification watermarks to identify documents. See Seder Figure 7



Art Unit: 2171

and the corresponding portions of Seder's specification for this disclosure. In particular Seder discloses that [other technologies can alternatively be employed. These include barcodes, data glyphs, RFID devices, magnetic stripes, organic transistors, smart cards, etc. (Seder: Paragraph 77, lines 2-5)].

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to use alternative methods to identify documents as evidenced by Seder above.

Per claim 4, the system and method of Rhodes in view of Ericson as applied to claim 1 and 2 above in view of Seder discloses the claimed invention. In particular, wherein the form version data is obtained by scanning a bar code [watermark].

The system and method of Rhodes in view of Ericson does not teach that the identification watermark could be in the form of a bar code.

Seder discloses a similar watermarking system to Rhodes modified by Ericson in that they both use identification watermarks to identify documents. See Seder Figure 7 and the corresponding portions of Seder's specification for this disclosure. In particular Seder discloses that "other technologies can alternatively be employed. These include barcodes, data glyphs, RFID devices, magnetic stripes, organic transistors, smart cards, etc." [Seder: Paragraph 77, lines 2-5].

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to use alternative methods to identify documents as evidenced by Seder above.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Osborne whose telephone number is 703-308-7911, (571)272-4027 as of 10/19/2004. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LRO  
9/30/2004

  
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